APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,729	11/14/2005	Hiroyuki Kikkoji	277537US6PCT	3279

22850   7590   08/28/2008
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EXAMINER
SU, EMILE

ART UNIT	PAPER NUMBER
4156	

NOTIFICATION DATE	DELIVERY MODE
08/28/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 November 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-11</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-11</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>5/11/2006</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1. This office action is in response to U.S. Application No. 10/556,729 filed on Nov 11, 2005.

2. **Claims 1-11** are pending.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR

3.73(b).

4.   **Claims 1 and 5** are provisionally rejected on the ground of nonstatutory obviousness-

type double patenting as being unpatentable over **Claims 1 and 7** of copending Application No.

10/557,193. Although the conflicting claims are not identical, they are not patentably distinct

from each other because all the elements in Claims 1 and 5 of current application are found in the

elements taught in Claims 1 and 7 of copending Application No. 10/557,193.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

<u>Current Application No. 10/556,729</u>	<u>Copending Application No. 10/557,193</u>

Claim 1
        A recording apparatus characterized by comprising:
        reception means for receiving contents-related information relating to contents contained in t broadcast information being received;
        temporary memory means for temporarily storing the contents-related information;
        related information recording means for recording the contents-related information stored in the temporary memory means in keeping means in response to a recording request input externally; and
        broadcast information recording means for recording the broadcast information being received in the keeping means, relating it to the related information to be recorded in the keeping means, in response to the externally input recording request.
	Claim 1
	        An information-recording apparatus characterized by comprising:
	        receiving means for receiving information related to a plurality of contents broadcast;
	        temporary storage means for temporarily storing the information items related to the contents;
	        storage means for storing any related information items;
	        instructing means for instructing that the related information items temporarily stored in the temporary storage means be recorded in the storage means;
	        recording means for recording the related information items stored in the temporary storage means, as a set, and the name of the set in association with the set, in the storage means, in response to an instruction made by the instructing means.

Claim 5	Claim 7
A recording method characterized by comprising: a reception step of receiving contents-related information relating to contents contained in broadcast information being received; a temporarily storing step of temporarily storing the contents-related information; a related information recording step of recording the contents-related information stored in the temporarily storing step in keeping means in response to a recording request input externally; and a broadcast information recording step of recording the broadcast information being received in the keeping means, relating it to the related information to be recorded in the keeping means, in response to the externally input recording request.	An information-recording method characterized by comprising the steps of: receiving information related to a plurality of contents broadcast; temporarily storing information items related to the contents, in temporary storage means; instructing that the related information items temporarily stored in the temporary storage means be recorded in storage means for storing any related information items; and recording the related information items stored in the temporary storage means, as a set, and the name of the set in association with the set, in the storage means, in response to the instruction.

Drawings

5.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **Fig 1, Reference 30**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6.   Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the **range of 50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as **"means" and "said," should be avoided**. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7.   The disclosure is objected to because of the following informalities:

applicant recites to "CPU1111" as opposed to "CPU11" on Page 21;

applicant recites to "Frequency information memory section 1056" as opposed to "Frequency information memory section 1058" on Page 44.

Appropriate correction is required.

8.   The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   **Claims 1-11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

     Regarding Claims 2 and 6, applicant recites "at specific time intervals in a ring shape". It is unclear whether the phrase means physically in a ring shape or conceptual arranged in a ring format. The examiner will interpret this phrase to mean "in a circular buffer" for the purpose of examination.

     Regarding Claims 3 and 7, applicant recites "arbitrarily defined". The adjective "arbitrarily" implies the meaning of not restrained or limited, and causes the claim to be indefinite. The examiner will interpret this phrase to mean "different buffer sizes" for the purpose of examination.

     Regarding Claims 4, applicant recites "by the broadcast information recording means" at the end of the claim. It is unclear how the related information is recorded by broadcast information recording means as it is not disclosed in the specifications. The examiner will interpret this phrase to mean "by the related information recording means".

     Regarding Claim 9, applicant recites "is receiving the contents" in Line 5 of the claim. It is unclear whether what device is receiving the contents. The examiner will interpret this phrase to mean "the terminal apparatus is receiving the contents" for the purpose of examination.

As to Claims 9 and 10, applicant recites "in the reception step" in the last line of both claims. The language and formatting is unclear what the applicant's intensions are. The examiner will interpret this phrase as being appended to the previous sentence for the purpose of examination.

Claims 1, 5, and 11 recite the limitation "the related information" in Line 13 of Claims 1 and 5, and Line 10 of Claim 10. There is insufficient antecedent basis for any limitation in the claims.

Claims 4 and 8 recite the limitation "the time point" in Line 4 of each claim. There is insufficient antecedent basis for either limitation in the claims.

Claim 9 recites the limitation "the service session ID" in Line 8 and "the authentication session ID" in Line 18 of the claim. There is insufficient antecedent basis for either limitation in the claim.

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12.   **Claims 5-10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under U.S.C. §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184

(1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70

(1972).

With respect to Claim 5, applicant claims a recording method without a sufficient tie to

another statutory class of machine, manufacture, or composition of matter and the method does

not transform underlying subject matter of information.

As to Claims 6-10, these claims all depend from Claim 5 and do not introduce a

sufficient tie to another statutory class nor transform the underlying subject matter.

13.   **Claim 11** is rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. A program to execute a process is a mathematical algorithm, which

is non-allowable subject matter as a Judicial Exception.

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

15.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16.   **Claims 1, 5 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Poltorak, U.S. Patent No. 7,164,882 (hereinafter referred to as Poltorak) in view of Levy et al.,

U.S. Patent No. 6,505,160 (hereinafter referred to as Levy).

> **Concerning Claim 1**, Poltorak teaches:

> reception means for receiving contents-related information relating to contents

contained in broadcast information being received (i.e. a receiver, see Poltorak, Abstract);

> temporary memory means for temporarily storing the contents-related information

(i.e. buffer, see Poltorak, Column 16, Line 62 through Column 17, Line 2);

> related information recording means for recording the contents-related

information stored in the temporary memory means in keeping means (see Poltorak,

Column 13 Lines 3-21);

> broadcast information recording means for recording the broadcast information

being received in the keeping means (i.e. media content, see Poltorak, Column 13 Lines

22-24; also see Column 13 Lines 3-21).

> Poltorak also teaches the use of input device to control operation (i.e. input

device, see Poltorak, Column 14, Lines 3-9), but does not specifically disclose using the

input device to control recording. Poltorak also does not disclose a method of relating

recorded information.

> Levy does teach a record function that is user activated (i.e. user activated, see

Levy, Column 14, Lines 43-58; also see Column 14, Line 34 through Column 15, Line

13). Levy also teaches a method of using an identifier to relate audio object to metadata (i.e. distributor or broadcaster identifier, see Levy, Column 10, Lines 36-49; also see Column 10, Lines 18-35 and Column 10, Line 50 through Column 11, Line 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Poltorak in view of Levy to create a recording apparatus that records and relates contents-related and broadcast information in response to an input, because the manual input of recording request increases user control over the recorded content and relating two recorded information will facilitate fast cross information retrieval.

As to Claims 5 and 11, see discussion of Claim 1 above.

17.   **Claims 2 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claims 1 and 5 above, further in view of Fiedler, U.S. Patent No. 6,204,419 (hereinafter referred to as Fiedler).

Concerning Claim 2, Poltorak discloses the invention substantially as claimed. Poltorak does not specifically teach one to use circular buffer design to store information. Fiedler does discuss the use of circular buffer to record audio information before and after a request to record (see Fiedler, Column 3, Lines 31-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to use circular buffer suggested by Fiedler in the recording apparatus of Poltorak to record information before and after a recording request, because circular buffer allows for more efficient operation by calculating only the necessary memory blocks.

As to Claim 6, see discussion above of Claim 2.

18.   **Claims 3 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak

in view of Levy, further in view of Fiedler as applied to Claims 2 and 6 above, and further in

view of Chan "Distributed Servers Architecture for Networked Video Services" (hereinafter

referred to as Chan).

        Concerning Claim 3, Poltorak discloses the invention substantially as claimed.

Poltorak does not specifically teach one to use different buffer size (note the examiner

has interpreted this claim with regards to discussion of 35 U.S.C. § 112 rejection above).

Chan discloses a research of caching scheme by adjusting the size of the buffer (see

Chan, Abstract). It would have been obvious to one of ordinary skill in the art at the time

of the invention to adjust the buffer design in Poltorak as suggested by Chan, because

different broadcast media require different buffer sizes.

        As to Claim 7, see discussion above of Claim 3.

19.   **Claims 4 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak

in view of Levy as applied to Claims 1 and 5 above, and further in view of Kim et al., U.S.

Patent No. 6,912,431 (hereinafter referred to as Kim).

        Concerning Claim 4, Poltorak discloses the invention substantially as claimed.

Poltorak does not specifically teach one to output a sound in response to a recording

request with the broadcast information being received. Kim does teach a method of using

sound output to identify a current state of an electronic device (see Kim, Abstract). It

would have bee obvious to one of ordinary skill in the art at the time of the invention to

add a sound output suggested by Kim to a recording apparatus disclosed by Poltorak to

notify the current state of the apparatus, because this provides audio feedback to the user about the current operation.

20.   **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claims 1 and 5 above, and further in view of Dujari et al., U.S. Patent No. 7,191,467 (hereinafter referred to as Dujari).

Concerning Claim 9, Poltorak discloses the invention substantially as claimed.

Poltorak does not specifically disclose a method of having an apparatus communicate with an authentication server and a related information providing server and receiving the content. Dujari does teach a process of using third party authentication between two servers (i.e. third party authentication service, see Dujari, Column 6, Lines 46-61).

Poltorak does not specifically disclose a method of transmitting request information requesting contents-related information to the related information providing server along with a session ID between the terminal apparatus and the related information providing server. Dujari does teach a process of requesting information from a server (i.e. HTTP GET, see Dujari, Column 7, Lines 25-34) and also teaches to use cookies as (i.e. cookies, see Dujari, Column 7, Lines 4-15; also see Column 7, Line 65 through Column 8, Line 3).

Poltorak does not specifically disclose a method of receiving, from the related information providing server, information indicating an authentication error and service identifying information for identifying the related information providing server. Dujari does teach a process of receiving an authentication error (i.e. HTTP 302, see Dujari,

Column 7, Lines 35-48) and service identifying information for identifying the related

information providing server (i.e. additional authentication related data, see Dujari,

Column 7, Lines 35-48).

Poltorak does not specifically disclose a method of transmitting authentication

ticket issuance request information requesting issuance of an authentication ticket for

accessing the related information providing server to the authentication server along with

a session ID between the apparatus and authentication server. Dujari does teach a process

of directing authentication request to another server (i.e. redirection to a third party login

server, see Dujari, Column 7, Line 49 through Column 8, Line 3).

Poltorak does not specifically disclose a method of receiving authentication ticket

from authentication server and transmitting authentication request information to related

information providing server along with authentication ticket. Dujari does teach a process

of using HTTP 302 redirect response along with cookies to transmit an authentication

request to a participating server (i.e. returns login server tickets in an HTTP 302, see

Dujari, Column 7, Line 49 through Column 8, Line 3).

Poltorak does not specifically disclose a method of receiving a service session ID

between the apparatus and related information providing server if authenticated. Dujari

does teach a process of using HTTP 200 success response along with cookies to

acknowledged a granting of access (i.e. an HTTP 200 response with its own cookie, see

Dujari, Column 7, Line 49 through Column 8, Line 3).

Poltorak also teaches transmitting a request for related information (i.e. step 505,

see Poltorak, Column 17, Line 52 through Column 8, Line 9), but does not teach

transmitting along with a session ID. Dujari discloses the use of cookies for session ID (see discussion above).

Poltorak also teaches receiving information that corresponds to related information request (i.e. step 512, see Poltorak, Column 18, Lines 44-55), but does not teach to be authenticated prior to receiving the information. Dujari discloses the use of cookies for session ID as a response of being authenticated (see discussion above).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Poltorak in view of Dujari by adding third party authentication process for receiving related information of a broadcast content, because authentication provides an increase of information security.

Concerning Claim 10, Poltorak discloses the invention substantially as claimed.

Poltorak does not specifically disclose receiving an authentication error and transmits a user ID and password to the authentication server. Dujari does teach using HTTP 401 code to response to an error and request for ID and password (i.e. HTTP 401, see Dujari, Column 8, Line 63 through Column 9, Line 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Poltorak in view of Dujari by using HTTP 401 status code to notify user of an error and prompt for user input, because this can prevent cryptanalysis using outdated information in cookies or caches.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES R. KYLE can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/
Examiner, Art Unit 4156
August 12, 2008

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4156